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OFFICE OF PETITIONS

In re Application of
Samueli et al
Application No. 09/252,551 (Reissue)
Filed: July 11, 2002
Attorney Docket No. 34176/JWE/B6

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: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.181(a)
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This is a decision based solely on petitioners' petition to withdraw the the holding of abandonment under 37 CFR 1.181(a).

The petition to withdraw the holding of abandonment is dismissed as moot. The supplemental notice of allowance mailed February 6, 2002 is vacated as mailed in error, and the holding of abandonment is withdrawn.

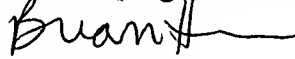
A review of the file reflects that on July 6, 2001 the Office mailed a notice of allowance requiring that applicant pay a twelve hundred hundred and forty dollar (\$1240.00) issue fee on or before October 09, 2001. On July 23, 2001 applicant paid the issue fee required by the Office. Subsequent to the payment of the issue fee, on February 6, 2002, the Office mailed a second notice of allowance with a second notice of allowability in response to a change of address, filed July 20, 2001.¹ The second notice of allowability did not require a reply. Furthermore, a second notice of allowance should not have been mailed because the application had not been withdrawn from issue (and the issue fee had been paid). The errant second notice of allowance required a response on or before May 6, 2002 and an additional fee of forty (\$40.00) dollars. Petitioners did not respond to the second notice of allowance and on June 3, 2002 the Office mailed a notice of abandonment for failing to timely pay the issue fee. Subsequent to the mailing of the notice of abandonment, the petitioners on July 11, 2002 filed this petition requesting the withdrawal of the holding of abandonment.

¹With the second notice of allowability the examiner indicated that the notice was in response to a paper filed July 20, 2001, a change of applicants' address. However, the supplemental examiner's amendment had nothing to do with a change of address. Rather the second notice of allowability accompanied an examiner's amendment cross referencing related reissue applications at the beginning of the specification. The examiner's amendment adding cross referenced material was to satisfy the requirements of 37 CFR 1.177(a). The examiner should only have mailed a supplemental notice of allowability, and not a second notice of allowance.

The Office will withdraw the holding of the abandonment because a second notice of allowance had, in this application, no force and effect in the absence of withdrawal of this application from issue pursuant to 37 CFR 1.313.² A complete reply to the first notice of allowance was filed with the issue fee payment on July 23, 2001. Thus, pursuant to 35 USC 151, the patent was to issue in due course. Absent formal and proper notification by a duly authorized USPTO official, after July 23, 2001, that this application had been withdrawn from issue, no proper subsequent notice of allowance could be mailed to petitioners. See Harley v. Lehman 981 F. Supp. 9, 11-12, 44 USPQ2d 1699, 1701-1702 (D.D.C 1997). Moreover, the supplemental examiner's amendment which incorporates into the specification all cross references of related reissue applications is not good and sufficient reason why the withdrawal of the application is necessary. Accordingly, the Office the unauthorized mailing of the second notice of allowance is vacated. See ExParte Brunner, 1872 Dec. Comm'r Pat. 62,63 (Comm'r Pat. 1972). As the latter action is vacated, there is no time period running against petitioner and no need to reply to the Notice of Allowance mailed February 6, 2002. Moreover, because the second notice of allowance is vacated, petitioner need not pay the additional \$40.00 fee required by the second notice of allowance.

After this decision is mailed, the application will be forwarded to the Office of Patent Publication for issuance of the patent.

Any questions related to this application should be directed to Kery Fries, Legal Advisor, Office of Patent Legal Administration, whose phone number is 703-308-0687.


Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of Deputy Commissioner
for Patent Examination Policy

²The petitioners are reminded, for future reference, to reply to any office action timely whether petitioners believe a response is necessary or not. Petitioners could have responded to the notice of allowance by merely pointing out that the second notice of allowance was in error and no further fee was due. By failing to respond to every notice of allowance, petitioners run the risk that the application properly abandoned may be held.